

ESTTA Tracking number: **ESTTA480605**

Filing date: **06/28/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Sturgis Motorcycle Rally, Inc.
Granted to Date of previous extension	07/04/2012
Address	1612 Junction Ave.Suite 4 Sturgis, SD 57785 UNITED STATES

Attorney information	Jason M. Sneed SNEED PLLC 610 Jetton St.Suite 120-107 Davidson, NC 28036 UNITED STATES JSneed@SneedLegal.com, Litigation@SneedLegal.com Phone:704-779-3611
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Applicant Information

Application No	85274747	Publication date	03/06/2012
Opposition Filing Date	06/28/2012	Opposition Period Ends	07/04/2012
Applicant	Nucci,Charles 1199 1/2 tennessee street san Francisco, CA 94107 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: HATS, SHIRTS, SWEATSHIRTS
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3923284	Application Date	01/30/2001
Registration Date	02/22/2011	Foreign Priority Date	NONE
Word Mark	STURGIS		

Design Mark	<h1>STURGIS</h1>
Description of Mark	NONE
Goods/Services	<p>Class 006. First use: First Use: 2006/08/31 First Use In Commerce: 2006/08/31 Metal key rings, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 008. First use: First Use: 1985/05/31 First Use In Commerce: 1985/05/31 Hand-operated hand tools, namely, hunting knives, pocket knives, sidearm knives, folding knives, sport knives, knives made of precious metal, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 009. First use: First Use: 1995/08/31 First Use In Commerce: 1995/08/31 Sunglasses, magnets and motorcycle helmets, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 013. First use: First Use: 1998/06/30 First Use In Commerce: 1998/06/30 Firearms, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 016. First use: First Use: 1987/08/31 First Use In Commerce: 1987/08/31 Pens; and paper goods and printed matter, namely, posters; bumper stickers; decals; iron-on and plastic transfers; window stickers; note pads; mounted photographs, and unmounted photographs; prints, namely, color prints, photographic prints, and pictorial prints; paper and plastic bags for packaging; and postcards; all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 020. First use: First Use: 2002/08/31 First Use In Commerce: 2002/08/31 Non-metal key rings and jewelry boxes not of metal, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 021. First use: First Use: 1995/08/31 First Use In Commerce: 1995/08/31 Glassware, namely, shot glasses, drinking glasses, drinking cups, and drinking mugs; insulating sleeve holders made of rubber, plastic or foam for beverage cans; insulating sleeve holders made of rubber, plastic or foam for beverage bottles; coasters not of paper and not being table linen; bottle openers; and beer steins; all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 024. First use: First Use: 2004/08/31 First Use In Commerce: 2004/08/31 Cloth flags, cloth banners, and quilts, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 025. First use: First Use: 1984/08/31 First Use In Commerce: 1984/08/31 Clothing, namely, shirts, T-shirts, long sleeve T-shirts, sleeveless T-shirts, denim shirts, golf shirts, jackets, coats, tank tops, polo shirts, sweatshirts, pullovers, women's tops, chemises, cloth wraps, head wear, bandannas, caps, cloth headwraps, hats, scarves, belts, chaps, gloves, and sun visors, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 026. First use: First Use: 1986/08/31 First Use In Commerce: 1986/08/31 Cloth and embroidered patches for clothing, ornamental cloth patches, hat pins for securing hats, belt buckles not of precious metal, and novelty ornamental pins, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 028. First use: First Use: 2001/06/30 First Use In Commerce: 2001/06/30</p>

	<p>Christmas tree ornaments and gaming chips, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 032. First use: First Use: 2005/06/30 First Use In Commerce: 2005/06/30 Bottled spring water and beer, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 033. First use: First Use: 2002/06/30 First Use In Commerce: 2002/06/30 Distilled liquor, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 035. First use: First Use: 2002/06/30 First Use In Commerce: 2002/06/30 Promoting sports competitions of others, namely, motorcycle and vehicle rallies, exhibits, and competitions; promoting the goods and services of others by arranging for sponsors to affiliate their goods and services with the STURGIS motorcycle rally; promoting economic development in the City of Sturgis and the Black Hills area of South Dakota and Wyoming; and on-line retail store services relating to the STURGIS motorcycle rally</p> <p>Class 041. First use: First Use: 2002/06/30 First Use In Commerce: 2002/06/30 Entertainment services in the nature of organizing and conducting motorcycle and vehicle exhibitions and rallies; organizing and conducting the entertainment events of others, namely, motorcycle and vehicle exhibitions, rallies, and competitions; and entertainment services in the nature of live civic productions</p>
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U.S. Registration No.	3818703	Application Date	03/29/2000
Registration Date	07/13/2010	Foreign Priority Date	NONE
Word Mark	STURGIS BIKE WEEK		
Design Mark	<p style="text-align: center;">STURGIS BIKE WEEK</p>		
Description of Mark	NONE		
Goods/Services	<p>Class 025. First use: First Use: 2000/09/00 First Use In Commerce: 2000/09/00 Clothing, namely, shirts, sweatshirts, bandanas, embroidered clothing, namely, shirts, sweatshirts</p>		

U.S. Registration No.	2698677	Application Date	06/01/2000
Registration Date	03/18/2003	Foreign Priority Date	NONE
Word Mark	TAKE THE RIDE TO STURGIS		
Design Mark	<p style="text-align: center;">TAKE THE RIDE TO STURGIS</p>		

Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1996/08/05 First Use In Commerce: 1996/08/05 Clothing - Namely, T-Shirts and Sweatshirts and Caps

U.S. Registration No.	1948097	Application Date	06/06/1994
Registration Date	01/16/1996	Foreign Priority Date	NONE

Word Mark	BLACK HILLS MOTOR CLASSIC STURGIS RALLY & RACES BLACK HILLS S.D.
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 035. First use: First Use: 1986/07/01 First Use In Commerce: 1986/07/01 promoting sports competitions and/or events of others, namely motorcycle rallies, exhibits and competitions; and promoting economic development in the city of Sturgis and the Black Hills area of South Dakota and Wyoming
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U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STURGIS RALLY & RACES		
Goods/Services	SHIRTS		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	STURGIS MOTORCYCLE RALLY		
Goods/Services	SHIRTS		

Attachments	76979104#TMSN.gif (1 page)(bytes) 76012841#TMSN.gif (1 page)(bytes) 78010763#TMSN.gif (1 page)(bytes) 74533873#TMSN.gif (1 page)(bytes) 2012-06-28 Notice of Opposition - SMRI v Charles Nucci - STURGIS CHOPPERS in Class 25.pdf (7 pages)(290306 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jason M. Sneed/
Name	Jason M. Sneed
Date	06/28/2012

In the matter of U.S. Trademark Application
Serial No. 85/274,747
Mark: STURGIS CHOPPERS
Filed: March 23, 2011
Published: March 6, 2012

Opposition No. _____

Sturgis Motorcycle Rally, Inc., a South Dakota not-for-profit company having a principal place of business at 1612 Junction Ave., Suite 4, Sturgis, South Dakota 57785 (“Opposer” or “SMRI”), believes that it will be damaged by the mark shown in Application Serial No. 85/274,747, filed March 23, 2011 by Charles Nucci, an individual having an address of 1199 ½ Tennessee Street, San Francisco, California 94107, and hereby opposes the registration of said mark.

1. Since long prior to the earlier of March 23, 2011, the date on which the subject intent-to-use application was filed by Applicant, or the actual date of first use of the STURGIS CHOPPERS mark by Applicant (if any such use has been made), Opposer, its predecessors, related companies and licensees (“Opposer and its Affiliates”) continuously have been in the business in this country of offering for sale and selling clothing products, including hats, shirts

and sweatshirts, in conjunction with the marks STURGIS®, STURGIS BIKE WEEK®, TAKE THE RIDE TO STURGIS®, STURGIS RALLY & RACE™, STURGIS MOTORCYCLE RALLY™, and a design mark referred to as the STURGIS Composite Design Mark of which the most prominent component is the word “STURGIS” (collectively, the “STURGIS Marks”).

2. By reason of the adoption and continuous use of the STURGIS Marks, these designations have a distinctive quality and have acquired special and particular significance and very valuable goodwill as identifying Opposer and its goods and services.

3. Opposer and its licensee, the City of Sturgis, South Dakota, are the official organizers and promoters for the STURGIS Motorcycle Rally, which is the largest and most famous motorcycle enthusiast event in the world, and which annually draws approximately half a million motorcycle enthusiasts and tourists to the City of Sturgis, South Dakota and surrounding Black Hills region of South Dakota and Wyoming. Opposer and its Affiliates use the STURGIS Marks in the organization, operation, sponsorship, promotion and administration of the STURGIS Motorcycle Rally, which event also has become famous and known to the public as “STURGIS” for short.

4. Consequently, through such usage and recognition, Opposer has acquired common law rights in and to the STURGIS Marks as proprietary trademarks and service marks, which rights extend, without limitation, to the exclusive right to use such designations nationwide in conjunction with Opposer’s goods and services offered and sold under the STURGIS Marks.

5. Further, the STURGIS mark is a famous mark that is distinctive, inherently or through acquired distinctiveness, in conjunction with, *inter alia*, the promotion and sponsorship of a motorcycle rally.

6. Opposer also is the owner of several U.S. registrations and applications for the STURGIS Marks, including:

- a. Registration No. 3,923,284 for the mark STURGIS, in connection with, *inter alia*, “Clothing, namely, shirts, T-shirts, long sleeve T-shirts, sleeveless T-shirts, denim shirts, golf shirts, jackets, coats, tank tops, polo shirts, sweatshirts, pullovers, women's tops, chemises, cloth wraps, head wear, bandannas, caps, cloth headwraps, hats, scarves, belts, chaps, gloves, and sun visors, all of the aforementioned goods relating to the STURGIS motorcycle rally” in International Class 25;
- b. Registration No. 3,818,703 for the mark STURGIS BIKE WEEK, in connection with “Clothing, namely, shirts, sweatshirts, bandanas, embroidered clothing, namely, shirts, sweatshirts” in International Class 25, with use as early as September 2000;
- c. Registration No. 2,698,677 for the mark TAKE THE RIDE TO STURGIS in connection with “Clothing – Namely, T-Shirts and Sweatshirts and Caps” in International Class 25, with use as early as August 1996;
- d. Registration No. 1,948,097 for the STURGIS Composite Design Mark, in connection with “promoting sports competitions and/or events of others, namely motorcycle rallies, exhibits and competitions; and promoting economic development in the city of Sturgis and the Black Hills area of South Dakota and Wyoming” in International Class 35, with use as early as July 1986.

(the above-listed registrations shall be referred to herein as “Opposer’s STURGIS Registrations”).

7. Opposer’s STURGIS Registrations are valid, subsisting and in full force and effect.

8. On March 23, 2011, Applicant filed the intent-to-use application at issue to register the term STURGIS CHOPPERS in connection with “HATS, SHIRTS, SWEATSHIRTS” in International Class 25.

9. Applicant’s mark contains two words, the first and most prominent of which is identical to Opposer’s STURGIS® mark, the first of the three words of Opposer’s STURGIS BIKE WEEK® mark and the most prominent component of Opposer’s TAKE THE RIDE TO

STURGIS® mark and STURGIS Composite Design Mark. The “CHOPPERS” component of Applicant’s mark modifies the first word of the mark, STURGIS, and connotes that the goods offered and sold or intended to be offered and sold by Applicant are or are related to motorcycles. “Choppers” is a generic or merely descriptive term meaning or referring to “motorcycles.”

10. Thus, Applicant seeks to register Opposer’s STURGIS® mark (when used in conjunction with goods pertaining to the STURGIS® Motorcycle Rally) in conjunction with a word, CHOPPERS, that means “motorcycles” to motorcycle enthusiasts, people familiar with motorcycles, and those likely to attend the STURGIS® Motorcycle Rally. These characteristics create a false impression or connotation that Applicant and his goods are associated, affiliated, approved, connected, or sponsored by Opposer and/or the STURGIS Motorcycle Rally, and, moreover, these characteristics create a likelihood of confusion with Opposer and its STURGIS Marks and the goods and services offered and sold thereunder.

11. Applicant’s goods and services are identical or substantially related to the goods and services offered and sold under and in conjunction with Opposer’s STURGIS Marks and described in Opposer’s STURGIS Registrations.

12. Accordingly, the Applicant’s mark, when used in connection with the goods and services listed in the application at issue, is likely to deceive or cause consumer confusion or mistake among members of the public and potential purchasers of the parties’ respective goods and services as to the source or sponsorship of Applicant’s goods and services in relation to Opposer and his goods and services.

13. Applicant’s application for registration should be refused on the basis that it creates, in violation of 15 U.S.C. § 1125(a), a false designation of origin, or a false or misleading

description of fact, or a false or misleading representation of fact, which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of the Applicant with the Opposer, the STURGIS Motorcycle Rally and Opposer's goods, services and commercial activities.

14. Applicant's application for registration should be refused on the basis that it consists of or comprises, in violation of 15 U.S.C. § 1052(d):

A mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

15. Applicant's application for registration also should be refused on the basis that it consists of or comprises, in violation of 15 U.S.C. § 1125(c), a mark or trade name used or to be used in commerce that is likely to cause dilution by blurring of the distinctive and famous STURGIS mark.

16. Opposer asserts, pursuant to 15 U.S.C. § 1063, that it will be damaged by the issuance of a registration for the STURGIS CHOPPERS mark to Applicant as sought in U.S. Application Serial No. 85/274,747.

WHEREFORE, Opposer, Sturgis Motorcycle Rally, Inc., requests that the application for registration of Applicant's mark be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Dated: June 28, 2012

Respectfully Submitted,

/s/ Jason M. Sneed
Jason M. Sneed, Esq.
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*Attorney for Opposer, Sturgis Motorcycle
Rally, Inc.*

Certificate of Filing

The undersigned certifies that this correspondence is being filed via electronic means by filing with the Electronic System for Trademark Trial and Appeals.

/s/ Jason M. Sneed

An Attorney for Opposer

Date of Signature: June 28, 2012

Certificate of Service

The undersigned counsel of record hereby certifies that a copy of the foregoing *Notice of Opposition* was served by placing a copy in U.S. Mail, postage prepaid, this 28th day of June, 2012 and addressed to the following:

Charles Nucci
1199 ½ Tennessee Street
San Francisco, California 94107
Applicant

/s/ Jason M. Sneed

An Attorney for Opposer